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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,401	01/22/2004	Ola Olofsson	TPP 31436DIV	3311

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EXAMINER

SELF, SHELLEY M

ART UNIT	PAPER NUMBER
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3725

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/761,401

Applicant(s)

OLOFSSON, OLA

Examiner

Shelley Self

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-25 and 27-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-25 and 27-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 15, 2006 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 20-25 and 27-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claims 20, 21, 24 and 27-30, it is unclear if Applicant is claiming an apparatus or a method claim. Examiner notes, that method steps are not given weight within an apparatus claim. Additionally, it appears as though Applicant is claiming the product, i.e. boards and the method by which the product (boards) are formed. Examiner suggests, constructing the claims in either clear apparatus or method claims. If the invention is drawn to an apparatus, what is the apparatus, i.e. the preamble states, "A system...", further stating "for forming..." such intended use recitation is not given patentable weight in an apparatus claim. Additionally, the preamble states, "A system for forming a surface comprising

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a plurality of boards, the system comprising”, if the system is for forming a surface having boards, how is it the system comprises a first and second board? The claims fail to positively recite any structure as it relates to the system and instead claims the boards having specific features, i.e. tongue, groove. Clarification is required. For the purposes of examination, Examiner understands the claims to be product-by-process claims.

Additionally with regard to claims 24 and 25, there is no antecedent basis for the recitation, “the polymeric material”, it is unclear how the polymeric material relates to the positively recited elements.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 20-22, 24, 25 and 27-30 as best as can be understood are rejected under 35 U.S.C. 102(e) as being anticipated by Serino et al. (6,357,197). With regard to claims 20, 24 and 27-30, Serino discloses a system for forming a surface comprising a plurality of boards, the system comprising, a first board having edges, at least one of the edges comprising a projecting tongue (16); and a second board (13) having edges at least one of the edges comprising a depressed groove (20; fig. 4A); wherein at least one of the tongue and groove comprising a milled portion and a broached portion, the broached portion having angles sharper than possible

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by milling (wherein at least one of the tongue and groove is formed by broaching an impregnated milled portion, clm. 28; wherein at least one of the tongue and groove comprise a burr-free broached portion, clm. 29; wherein at least one of the tongue and groove comprise a broached portion having a geometry not capable of being formed by milling, clm. 30) such that the at least one of the tongue and groove are shaped to form a joint.

As to the recitation, "...the broached portion having angles sharper than possible by milling", (clm. 20) this is treated as a product-by-process limitation, as, the claim positively defines either the tongue or groove to have both milled and broached portions and the tongue and groove to form a joint. Examiner notes that either the tongue or groove, having a broached portion having angles sharper than possible by milling, does not positively define an end resultant product, i.e. surface comprised of a plurality of boards having a joint connection between the boards that is patentably distinct from the prior art of record. Further examiner notes the process by which the end result product (surface comprised of plurality of boards having a joint connection between the boards) is made is not germane to the patentability of the end resultant product.

Regarding claims 20, 24 and 27-30, Examiner notes, *"wherein at least one of the tongue and groove comprise both a milled and a broached portion"*, *"the groove comprises both milled and broached portions"*, *"wherein the polymeric material...formed by extrusion before being milled"*, *"wherein at least one of the tongue and the groove is formed by broaching an impregnated milled portion"*, *"wherein at least one of the tongue and the groove comprising a burr-free broached portion"* and *"wherein at least one of the tongue and groove comprise a broached portion...not capable of being formed by milling"* to be product-by-process limitations.

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Accordingly, because Serino clearly discloses a (product) first and second boards having a tongue and groove joint, the process by which the tongue and groove of the boards is formed into a joint (i.e., milled, broached, sharp angles, burr-free & geometry not capable of being formed by milling) or extrusion before milling are not germane to the patentability of the claimed invention. Additionally, the claimed end resultant product (at least two boards having a tongue and groove joint/connection to create a surface) does not patentably distinguish over the prior art of record.

With regard to claim 21 as best as can be understood, Serino discloses the tongue and groove both to comprise a polymeric material. Examiner notes the adhesive (19) between the tongue and groove to be a polymeric material because it consists of a thermoplastic. Applicant's disclosure states an admitted prior art that, thermoplastic is a type of polymeric material. Accordingly because Serino discloses board (17) to be comprised of a thermoplastic material and use of an adhesive that is also a thermoplastic material, Serino anticipates a tongue and groove comprised of polymeric material.

With regard to claim 22 as best as can be understood, Serino discloses the tongue (16) to be glued (18) to the board (13).

With regard to claim 23 as best as can be understood, Serino discloses a polymeric material (col. 3, lines 35-50), Examiner notes a thermoplastic polymer to be a polymer material.

With regard to claim 25 as best as can be understood, Serino discloses wherein at least one of the first board and the second board comprises a core, the core being formed from wood fiber board (col. 3, lines 14-17, 35-37).

Response to Arguments

Applicant's arguments filed November 15, 2006 have been carefully considered but they are not persuasive. Applicant's remarks are drawn to the failure of the prior art, Serino et al to disclose or fairly suggest "*the broached portion has angles sharper than possible by milling...the broached portion is burr-free...the broached portion has a geometry not capable of being formed by milling*". This argument is not deemed persuasive, because as noted above, these limitations are product-by-process limitations and lend to the method steps by which the surface comprising a first and second board is formed. The end resultant product of a surface formed via at least a first and second board, one of the boards having a projecting tongue the other of the boards having a depressed groove, such that the boards form a joint/connection fails to patentably distinguish over the surface/boards disclosed by Serino. Further as noted above, the method steps, or process is not germane to the patentability of the end resultant product in the absence of any clear patentably distinguishing structure of the end resultant product. For example, both the prior art of record, Serino and the presently presented application disclose a end result product of a surface comprised of at least two boards, the boards joined via tongue and groove joint, i.e. Applicant's claimed method/process steps fail to define any structure in the end resultant product that is different or patentably distinguishing over that of the prior art, Serino; both teach, disclose finished surfaces joined by a tongue and groove joint, the method and/or process of forming the tongue and groove joint is not given patentable weight as the end resultant product of the reference and the Applicant is the same.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is 571-272-4524. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lowell Larson can be reached on 571-272-4519. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



SSelf
Patent Examiner
January 18, 2007